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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,144	06/23/2000	Gregory Jones	5053-28000	1593

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EXAMINER

FRENEL, VANEL

ART UNIT PAPER NUMBER

3626

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/603,144	<b>Applicant(s)</b> JONES ET AL.	
	<b>Examiner</b> Vanel Frenel	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 41-45, 47, 48, 50-53, 55-60, 62-65 and 67-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-45, 47, 48, 50-53, 55-60, 62-65 and 67-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/28/05 has been entered.

#### **Notice to Applicant**

2. This communication is in response to the RCE filed on 02/28/05. Claims 41-43, 47, 51, 59 and 63 have been amended. Claims 46, 49, 54, 61 and 66 have been canceled. Claims 71-75 are newly added. Claims 41-45, 47-48, 50-53, 55-60, 62-65 and 67-75 are pending.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 41-75 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basic of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technology arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technology arts. More ideas, in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts to promote the “progress science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. Looking at the claims 41-70 as a whole, nothing in the body of the claims recite any structure of functionality to suggest that a computer performs the recited steps.

As such, the above deficiencies may be cured by simply explicitly reciting that the claimed method/process steps are embodied or implemented on a “computer system” or on a “computer readable medium” (as appropriate), provided Applicant show proper support for such recitations in the originally filed specification.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 41-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (4,987,538) in view of McKee et al (6,272,482) and further in view of Reid et al (6,560,592).

(A) As per claim 41, Johnson discloses a system comprising: a database comprising a plurality of business rule data elements (Col.3, lines 8-49 to Col.4, line 41); a translator program configured to read two or more business rule data elements from the database using information from the template table, and to combine two or more business rule data elements to form at least one business rule (Col.3, lines 8-49 to Col.4, line 41).

Johnson does not explicitly disclose a rules engine configured to assess a value of one or more bodily injury insurance claims as a function of at least one of the formed business rules.

However, this feature is known in the art, as evidenced by McKee. In particular, McKee suggests a rules engine configured to assess a value of one or more bodily injury insurance claims as a function of at least one business rules (See McKee Col.4, lines 25-67 to Col.5, line 52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of McKee within the system of Johnson with the motivation of providing a method and system for managing business rules, which facilitates an understanding of the interactions of business rules, and simplifies revision of the rules as required by changes in business procedures and policies (See McKee Col.2, lines 50-53).

Johnson and McKee do not explicitly disclose a rules data table, a template, and a text table, wherein the rules data table comprises; wherein the text table stores elements of text that may be used to generate the one or more business rules; using information from the template table, wherein the one or more business rules are classified into a plurality of rule styles, wherein a syntax for a rule premise and a syntax for a resulting rule action for a given rule style are common to business rules within the rule style.

However, these features are known in the art, as evidenced by Reid. In particular, Reid teaches a rules data table (See Reid, Col.3, lines 57-67), a template (See Reid, Col.27, lines 6-21), and a text table (See Reid, Col.20, lines 1-11); wherein the text table stores elements of text that may be used to generate the one or more business rules (See Reid, Col.19, lines 29-67 to Col.20, line 11); using information from the template table (Col.27, lines 13-45), wherein the one or more business rules are classified into a plurality of rule styles, wherein a syntax for a rule premise and a syntax for a resulting rule action for a given rule style are common to business rules within the rule style (See Reid, Col.10, lines 11-67; Col.19, lines 29-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Reid within the collective teachings of Johnson and McKee with the motivation of providing a premise which has an action, wherein the action is performed if the premise is determined to be true; an alternate action, wherein the alternate action is performed if the premise is determined to be false; and a trigger,

wherein the trigger causes evaluation of the premise upon the occurrence of a predetermined event (See Reid, Col.4, lines 54-59).

(B) As per claim 42, Reid discloses the system wherein the value of the at least one of the insurance claims comprises a trauma severity value (The Examiner interprets diagnosing respiratory illnesses to be a form of trauma severity value (See Reid, Col.1, lines 30-33)).

(C) As per claim 43, Reid discloses the system wherein the rules data table comprises a plurality of rows and a plurality of columns (See Reid , Fig.13).

(D) As per claim 44, Johnson discloses wherein at least one business rule comprises logical instructions for assessing the value of the insurance claim (Col.3, lines 8-67 to Col.4, line 67).

(E) As per claim 45, McKee discloses the system wherein at least one business rule comprises a premise and one or more resulting actions for assessing the value of the insurance claim (See McKee Col.4, lines 25-67 to Col.5, line 52).

(G) As per claim 47, Johnson discloses a method of implemented on a computer system, comprising providing a plurality or business rule data elements in a rules data table in a memory of a computer system (See Johnson, Col.3, lines 8-13); combining

two or more business rule data elements to form at least one business rules for processing one or more bodily injury insurance claims (See Johnson, Col.1, lines 13-38).

Johnson does not explicitly disclose providing at least one of the formed business rule to a rules engine, wherein the formed business rule is executable by the rules engine to process at least one of the insurance claims.

However, this feature is known in the art, as evidenced by McKee. In particular, McKee suggests providing at least one of the formed business rules to a rules engine, wherein at least one formed business rule is executable by the rules engine to process at least one of the insurance claims (See McKee Col.4, lines 25-67 to Col.5, line 52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of McKee within the system of Johnson with the motivation of providing a method and system for managing business rules, which facilitates an understanding of the interactions of business rules, and simplifies revision of the rules as required by changes in business procedures and policies (See McKee Col.2, lines 50-53).

Johnson and McKee do not explicitly disclose reading data from the rules data using information from a template; reading elements of text from a text table; wherein the one or more business rules are classified into a plurality of rule styles, wherein a syntax for a rule premise and a syntax for a resulting rule action for a given rule style are common to business rules within the rule style.



However, these features are known in the art, as evidenced by Reid. In particular, Reid suggests reading data from the rules data using information from a template (See Reid, Col.27, lines 13-45); reading elements of text from a text table (See Reid, Col.8, lines 9-23); wherein the one or more business rules are classified into a plurality of rule styles, wherein a syntax for a rule premise and a syntax for a resulting rule action for a given rule style are common to business rules within the rule style ((See Reid, Col.10, lines 11-67; Col.19, lines 29-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Reid within the collective teachings of Johnson and McKee with the motivation of providing a premise which has an action, wherein the action is performed if the premise is determined to be true; an alternate action, wherein the alternate action is performed if the premise is determined to be false; and a trigger, wherein the trigger causes evaluation of the premise upon the occurrence of a predetermined event (See Reid, Col.4, lines 54-59).

(H) As per claim 48, McKee discloses the method further comprising processing at least one insurance claim by executing at least one formed business rule in the rules engine (See McKee, Col.3, lines 45-67).

(J) As per claim 50, Johnson discloses the method wherein at least one formed business rule is executable by the rule engine to assess a trauma severity value of a bodily injury insurance claim (Col.1, lines 13-57).

(K) As per claim 52, Johnson discloses the method wherein the rules engine comprises program instructions which are executable by a computer to access at least one formed business rule and to assess an insurance claim based on at least one accessed business rule (Col.5, lines 31-68 to Col.5, line 68; Col.6, line 35-68).

(L) As per claim 55, Johnson discloses the method further comprising: modifying at least one business rule data element in the memory and combining at least two business rule data elements, including at least one modified business rule data element, to form at least one modified business rule (Col.2, lines 56-68 to Col.3, line 25).

(M) As per claim 56, Johnson discloses the method further comprising: modifying at least one business rule data element as function of business requirements of an insurance organization (Col.2, lines 56-68 to Col.3, line 25).

(N) As per claim 57, Johnson discloses the method further comprising: modifying at least one business rule in response to modifying at least one business rule data element (Col.2, lines 56-68 to Col.3, line 25).

(O) As per claim 58, Johnson discloses the method further comprising: forming at least one new business rule in response to modifying at least one business rule data element (Col.2, lines 56-68 to Col.3, line 25).

(P) As per claim 59, Johnson discloses a carrier medium comprising program instructions implemented on a computer system, wherein the program instructions are computer-executable to implement: providing a plurality of business rule data elements in a memory of a computer system (Col.2, lines 1-68 to Col.3, line 25); combining two or more of the business rule data elements of the plurality of business rule data elements to form at least one business rule for processing an insurance claims (Col.1, lines 13-38).

Johnson does not explicitly disclose providing at least one formed business rules to a rules engine, wherein the formed business rule is executable by the rules engine to process at least one insurance claims.

However, this feature is known in the art, as evidenced by McKee. In particular, McKee suggests providing at least one formed business rules to a rules engine, wherein the formed business rule is executable by the rules engine to process at least one insurance claims (See McKee Col.4, lines 25-67 to Col.5, line 52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of McKee within the system of Johnson with the motivation of providing a method and system for managing business rules, which facilitates an understanding of the interactions of business rules, and simplifies revision of the rules as required by changes in business procedures and policies (See McKee Col.2, lines 50-53).

Johnson and McKee do not explicitly disclose reading data from the rules data using information from a template; reading elements of text from a text table; wherein the one or more business rules are classified into a plurality of rule styles, wherein a syntax for a rule premise and a syntax for a resulting rule action for a given rule style are common to business rules within the rule style.

However, these features are known in the art, as evidenced by Reid. In particular, Reid suggests reading data from the rules data using information from a template (See Reid, Col.27, lines 13-45); reading elements of text from a text table (See Reid, Col.8, lines 9-23); wherein the one or more business rules are classified into a plurality of rule styles, wherein a syntax for a rule premise and a syntax for a resulting rule action for a given rule style are common to business rules within the rule style ((See Reid, Col.10, lines 11-67; Col.19, lines 29-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Reid within the collective teachings of Johnson and McKee with the motivation of providing a premise which has an action, wherein the action is performed if the premise is determined to be true; an alternate action, wherein the alternate action is performed if the premise is determined to be false; and a trigger, wherein the trigger causes evaluation of the premise upon the occurrence of a predetermined event (See Reid, Col.4, lines 54-59).

(Q) As per claim 60, Johnson discloses the carrier medium wherein the program instructions are further computer-executable to implement processing at least one

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insurance claim by executing at least one formed business rule in the rules engine  
(Col.2, lines 1-68 to Col.3, line 25).

(R) Claims 51, 53, and 60, 62-65, and 67-70 recite the underlying process steps of the elements of claims 43, 45, 50-52 and 55-58. As the various elements of claims 43, 45, 50-52 and 55-58 have been shown to be either disclosed by or obvious in view of the collective teachings of Johnson and McKee, it is readily apparent that the carrier-medium disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 51, 53, and 60, 62-65, and 67-70 are rejected for the same reasons given above for claims 43, 45, 50-52 and 55-58 and incorporated herein.

(S) As per claim 71, Reid discloses the computer system wherein the template table comprises a rule name and a rule style for at least two of the business rules (Col.19, lines 29-47).

(T) As per claim 72, Reid discloses the computer system wherein at least two of the plurality of rule styles has an entry in the template table (Col.27, lines 1-21).

(U) As per claim 73, Reid discloses the computer system wherein the rules data table comprises a rule style column, wherein an entry in the rule style column is used as a key to find a matching record in the template table (Col.27, lines 1-43).

(V) As per claim 74, Reid discloses the computer system wherein a syntax used to construct the one or more business rules is specified in the template table for at least two of the plurality of rule styles (See Reid, Fig.21; Fig.23; Col.19, lines 29-47).

(W) As per claim 75, Reid discloses the computer system wherein the template table comprises a line text identifier for text in the text table (See Reid, Col.13, lines 1-19).

### ***Response to Arguments***

7. Applicant's arguments filed on 02/28/05 with respect to claims 41-45, 47-48, 50-53, 55-60, 62-65, 67-75 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches aggregating constraints and/or preferences using an inference engine and enhanced scripting language (6,681,380), notification by business rule trigger control (6,775,658) and Investigations into database management system support for expert system shells. (Volumes I and II) by Jonhson, Verlyn Mark, Ph.D., University of Minnesota, 1993, 573 pages; AAT 9312489.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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**ALEXANDER KELNOWSKI**  
**PRIMARY EXAMINER**

May 16, 2005